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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,076	10/30/2003	Robert T. Clark	33737/US	8144

7590 04/14/2009  
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Minneapolis, MN 55402-1498

EXAMINER
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PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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04/14/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,076	<b>Applicant(s)</b> CLARK ET AL.	
	<b>Examiner</b> JAMISUE A. PLUCINSKI	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10 and 12-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10 and 12-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6-10, 15-22, 23-25, 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claim 6: the phrase "calculating a score indicative of a level of risk of identity theft fraud using the determined demographic data" is indefinite. The score that is calculated in the specification using demographic data is one that determining the differences of two addresses, therefore it is unclear how the score is being calculated using the demographic information if there is only one address present.

4. With respect to Claim 7: the phrase "further comprising receiving a reference address" is indefinite. How is the address chosen, is this a random reference address or if the reference address is determined, what information is used to determine the reference address? If it is a random address, would there be any meaning to the score?

5. With respect to Claim 10: This claim indicates that the demographic data is determined related to the reference address and the difference is determined between the two addresses, however the claim never indicates what the difference is used for, is it used to calculate the score which is outlined in Claim 6?

6. With respect to Claim 15: the claim recites receiving street addresses, determining demographic differences between the street addresses, then using demographic attributes of

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street addresses to predict the risk of fraud. Are the street addresses the same that is received in the first step? It is also unclear to the examiner if the demographic attributes of the addresses are used to assess fraud, or if it is the differences between the addresses. It is also unclear to the examiner the relationship between the addresses, or if they are random addresses.

7. With respect to Claim 23: It is unclear to the examiner how the information is combined to predict a risk of fraud. The claims states the information is combined, but now how it is combined.

8. Claim 23 recites the limitation "the addresses" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim. The claim states a warm address, but the only other address being used is fraud address information, not necessarily the address itself, therefore unclear what "the addresses" is referring to.

9. With respect to Claim 24: the claim discloses instructions for processing data, however fails to disclose how the data is received in the system, are there instructions for collecting the data, or is the data located in the memory?

10. Claim 25 recites the limitation "the independent variables" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

11. With respect to Claim 30: The claim recites the use of analyzing two street address and demographic data associated with the street addresses. The claim never collects street addresses, nor demographic addresses, therefore it is unclear where it comes from. The claim must be complete in and of itself, therefore it is positively uses information, then it must obtain the information first.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-3, 4-10, 12-23, and 26-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed.

4. In Claim 29 the claim is directed towards a system with inputs, an interface and a scoring module. The system claim is in essence an apparatus claim, and therefore should be directed towards structure. The applicant has claimed a system claim with no real structure, only software modules which are run on computers, but has not claimed the computer itself. Therefore causing the claims to not be tangible and not directed towards statutory subject matter.

5. In Claims 1-3, 4-10, 12-23, 26-28 and 30-33, the claims are drawn to a method. For purposes of 101, a "process" has been given a specialized, limited meaning by the courts. Based on *In re Bilski* (Federal Circuit 2007-1130), the court outlined a test used to determine whether a method satisfies 35 USC 101, is a machine-or-transformation test. *In re Bilski* states "the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are

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applicable to analysis under either branch. First as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 US at 590. the claims are drawn to a method for assessing a risk of fraud, however no where in the claims is there a recited the use of any particular machine and therefore the claims do not pass the machine-or-transformation test and are hence not directed to statutory subject matter.

### ***Response to Arguments***

6. Applicant's arguments, filed 9/2/08, with respect to the 112 1<sup>st</sup> paragraph rejection have been fully considered and are persuasive. The rejection of claims 1-33 has been withdrawn.

7. With respect to the art rejection: Due to the numerous 112 2nd paragraph rejections as well as the 101 rejections, a lack of prior art does not indicate the claims are allowable at this time.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629